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A. B. Bittner

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Steven R. PEARL, *et al.*

Ser. No.: 09/807,592

Group Art Unit: 1723

Filed: May 23, 2001

Examiner: J. Kim

For: HOLLOW FIBER SEPARATION MODULE
AND METHOD FOR MANUFACTURING SAME

Bedford, Massachusetts 01730
October 24, 2002

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

A Written Restriction Requirement (Paper No. 5) mailed September 27, 2002, was received. Applicants' election of invention with traverse (Group II) is presented below.

REMARKS

Restriction has been required between the claims of Group I "drawn to a multi-layered coiled hollow fiber" (claims 1-11); Group II "drawn to a method for producing a multi-layered coiled hollow fiber" (claims 12-18); Group III "drawn to a method for manufacturing a multi-layered separation module" (claims 19-21); and Group IV "drawn to single-layered coiled hollow separation module" (claims 22-25).

The Written Restriction Requirement admits that "[a]ll of the groupings are directed to method or apparatus for coiled hollow fiber bundle", but asserts that "each group has a different special technical feature not shared by any of the remaining groups".

Applicants respectfully request favorable reconsideration of the restriction requirement and request action on the merits of all of the claims of the subject application.

Requirement for restriction is discretionary. It is the expressly stated policy of the PTO (M.P.E.P. 803) to examine all of the claims on the merits where the search and examination of an entire application can be made without serious burden. It is submitted that the claims of the respective groups can be conveniently examined without serious burden. As admitted, "[a]ll of the groupings are directed to method or apparatus for coiled hollow fiber bundle."

Applicants acknowledge that the leading claims of each group contain certain different subject matter. However, that is the nature of an independent claim. Applicants question whether the mere observation of a "different special technical feature" in the claims is alone sufficient grounds for issuing a restriction requirement. Such a low threshold would essentially undermine the express statutory provisions permitting use of more than one independent claim.

Although applicants are aware that restriction requirements are not uncommon, the instant restriction is particularly troublesome considering the large number of separate groupings the

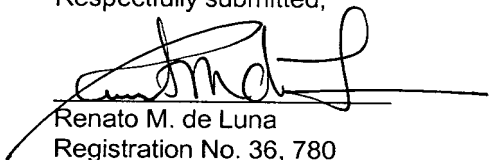
examiner has identified. The pursuit of each group separately in different divisional applications will effectively quadruple applicants' prosecution costs. Applicants do not feel that the case for restriction is so strong here, that their burden should be enhanced so severely.

Withdrawal of the restriction requirement is earnestly sought.

Regardless, in the interest of providing a full and proper response to the requirement, should the requirement become final, applicants hereby traverse the requirement by electing to prosecute the subject matter encompassed within Group II (claims 12-18) without prejudice to applicants' rights under the provisions of 37 C.F.R. § 1.144 and 35 U.S.C. § 121. Inventorship is unchanged despite the election.

Applicants' specification and claims are believed to be in proper form and describe an invention which is patentably distinct from the prior art. Favorable disposition is respectfully requested.

Respectfully submitted,


Renato M. de Luna
Registration No. 36, 780

RMD/-
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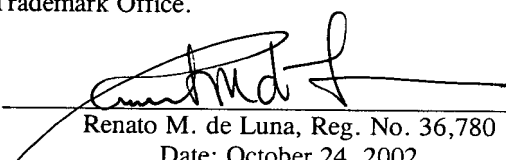
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Renato M. de Luna, Reg. No. 36,780
Date: October 24, 2002